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| TUROCY & WATSON, LLP 127 Public Square 57th Floor, Key Tower CLEVELAND, OH 44114 | | | EXAMINER PEARSON, DAVID J | |
| | | | ART UNIT 2437 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/729,798

Applicant(s)

HIRST, ROY

Examiner

DAVID J. PEARSON

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1, 6, 11-16 and 21-22 have been amended. Claims 1-17 and 20-25 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/06/2009 has been entered.

Response to Arguments

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

5. Claims 1-5 and 11-15 are objected to because of the following informalities:
Claim 1 recites, "encrypting the combination of the unique identifier and the digitally-encoded material." However, this phrase lacks antecedent basis because there

is no "a combination of the unique identifier and the digitally-encoded material" introduced. A unique identifier is associated with digitally-encoded material, but this does not constitute "a combination." A unique identifier can be "associated" with digitally-encoded material without necessarily being "combined" with the digitally-encoded material.

Claims 2-5 inherit the deficiency of the claim they depend on.

Claim 11 recites, "a list of processors associated with each **or** the built-in functions" (emphasis added). Examiner believes this to be a typographical error and the claim should read "associated with each of the built-in..." The claims will be treated as such for the remainder of the Office Action.

Claims 12-15 inherit the deficiency of the claim they depend on.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. Claims 1, 5-6, 8-16 and 20-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Shen et al. (U.S. Patent Application Publication 2003/0149890; hereafter referred to as "Shen"), and further in view of Bohannon et al. (U.S. Patent 6,134,324; hereafter referred to as "Bohannon").

For claims 1, 11 and 16, Shen teaches a method and computer readable storage medium of storing digitally encoded material, the method comprising:

Employing a processor to execute computer executable instructions stored in memory to perform the following acts (note paragraphs [0034]-[0035]):

Associating a unique identifier with digitally encoded material (note paragraph [0064]) and encrypting the combination **of the unique identifier and the digitally-encoded material** (note paragraph [0034]); and

Associating a plurality of (note paragraph [0059]) built-in functions (note paragraph [0085]) with the encrypted digitally encoded material such that the unique identifier and the built-in functions are coupled to the digitally encoded material (note paragraph [0034]); and

Rendering or transforming the digitally-encoded material based on the built-in functions (note paragraph [0094]), wherein the digitally-encoded material can be transformed and rendered only by the built-in functions (note paragraph [0017]).

Shen differs from the claimed invention in that they fail to teach:

Storing a list of processors that are permitted to execute the built-in functions;

Receiving information regarding a first processor attempting to execute one or more of the built-in functions;

Verifying if the first processor attempting to execute the built-in functions is on the list of processors;

Permitting the first processor to execute the one or more built-in functions if the processor is on the list else preventing the first processor from executing the one or more built-in functions.

Bohannon teaches:

Storing a list of processors that are permitted to execute the built-in functions (note column 8, lines 5-7);

Receiving information regarding a first processor attempting to execute one or more of the built-in functions (note column 8, lines 37-38);

Verifying if the first processor attempting to execute the built-in functions is on the list of processors (note column 8, lines 38-40);

Permitting the first processor to execute the one or more built-in functions if the processor is on the list else preventing the first processor from executing the one or more built-in functions (note column 8, lines 40-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the built in functions of Shen and the processor verification of Bohannon. One of ordinary skill would have been motivated to combine Shen and Bohannon because verifying the processor is on a list of authorized processors would ensure that only licensed computers are handling the content (note column 3, lines 19-23 of Bohannon).

For claims 6 and 21, the combination of Shen and Bohannon teaches a method and computer readable medium for tracking digitally encoded material, the method comprising:

Employing a processor to execute computer executable instructions stored in memory to perform the following acts (note paragraphs [0034]-[0035] of Shen):

Appending a unique identifier to the digitally encoded material (note paragraph [0064] of Shen);

encrypting a combination including the digitally encoded material and the unique identifier (note paragraph [0034] of Shen); and

appending built-in function source code (note paragraph [0085] of Shen) **to** the encrypted combination to form an executable entity (note paragraph [0037] of Shen) capable of being executed independent of a particular operating system (note paragraph [0015] of Shen), wherein the digitally-encoded material can be transformed and rendered only by the built-in functions (note paragraph [0017] of Shen);

Storing a list of processors that are permitted to execute the built-in functions (note column 8, lines 5-7 of Bohannon);

Receiving information regarding a disparate processor accessing the built-in function source code for execution (note column 8, lines 37-38 of Bohannon);

allowing the disparate processor to execute a function associated with the built-in function source code if the disparate processor is included in a list of

processors permitted to execute the function (note column 8, lines 38-47 of Bohannon);

barring the disparate processor from executing the function associated with the built-in function source code if the disparate processor is not included in the list of processor permitted to execute the function (note column 8, lines 38-47 of Bohannon).

For claims 5, 12 and 20, the combination of Shen and Bohannon teaches claims 1, 11 and 16 further including an encrypt function (note paragraph [0015] of Shen) and a decrypt function (note paragraph [0032] of Shen) the built-in functions that enables the digitally encoded material to be stored in RAM in an encrypted form (note paragraph [0094] of Shen).

For claims 8 and 13, the combination of Shen and Bohannon teaches claims 6 and 11 wherein the built-in functions include rendering functions (note paragraph [0094] of Shen) and transform functions (note paragraph [0032] of Shen).

For claims 9 and 14, the combination of Shen and Bohannon teaches claims 8 and 13 wherein the rendering functions include one or more of a close, find shape, full screen, go to guide, help, open (note paragraph [0094] of Shen), order pan, properties, reveal, rotate/flip, search, select, size, and position, spell check or zoom.

For claims 10 and 15, the combination of Shen and Bohannon teaches claims 8 and 13 wherein the transform function include one or more of copy, DRM agent (note paragraph [0032] of Shen), export, insert, log, new, paste, print, replace, or save as.

7. Claims 2-3, 17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shen and Bohannon, and further in view of Matsuyama et al. (U.S. Patent 6,574,611, hereafter "Matsuyama").

For claims 2-3 and 17, the combination of Shen and Bohannon differs from the claimed invention in that they fail to teach:

Associating a history of the digitally encoded material with the digitally encoded material, wherein the history being located in a database.

Matsuyama teaches:

Associating a history of the digitally encoded material with the digitally encoded material (note column 23, lines 52-56), wherein the history being located in a database (note column 23, lines 11-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Shen and Bohannon and the usage history of Matsuyama. One of ordinary skill in the art at the time of the invention would have been motivated to combine Shen, Bohannon and Matsuyama because it would provide a way

for content providers to be compensated based on the usage of the content (note column 11, line 55 through column 12, line 8 of Matsuyama).

For claim 22, the combination of Shen, Bohannon and Matsuyama teaches claim 21 wherein the **method** further comprise:

tracking the digitally encoded material by maintaining an auditable document history log (note column 23, lines 52-56 of Matsuyama).

For claim 23, the combination of Shen, Bohannon and Matsuyama teaches claim 22 wherein the auditable document history log is maintained in one of a file associated with the digitally-encoded material and a database independent of the digitally-encoded material (note column 23, lines 11-21 of Matsuyama).

8. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shen and Bohannon as applied to claims 1 and 6 above, and further in view of Rabinovitch (U.S. Patent Application Publication 2006/0101521).

For claims 4 and 7, the combination of Shen and Bohannon differs from the claimed invention in that they fail to teach:

wherein the built-in function includes one or more of Copy, Paste or Print.

Rabinovitch teaches:

wherein the built-in function includes one or more of Copy, Paste or Print (note paragraph [0047]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Shen and Bohannon and the copy and print control functions of Rabinovitch. One of ordinary skill in the art would have been motivated to combine Shen, Bohannon and Rabinovitch because it would increase the management of the digital content by allowing control over copying and printing of the content.

9. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shen and Bohannon as applied to claim 10 above, and further in view of Nelson (U.S. Patent 6,691,229).

For claim 24, the combination of Shen and Bohannon differs from the claimed invention in that they fail to teach:

Including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated copy of the digitally encoded material such that the copy comprises the unique identifier and the second unique identifier.

Nelson teaches:

Including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated copy of the digitally encoded material such that the copy comprises the unique identifier and the second unique identifier (note column 7, line 57 through column 8, line 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Shen and Bohannon with the enforcement data of Nelson. One of ordinary skill in the art at the time of the invention would have been motivated to combine Shen, Bohannon and Nelson because it would allow unauthorized copies of content to be traced to the person who accepted the original (note column 4, lines 38-42 of Nelson).

For claim 25, the combination of Shen, Bohannon and Nelson teaches claim 24, wherein executing the copy function updates document history of the digitally encoded material and the generated copy (note column 23, lines 52-56 of Matsuyama) and informs at least an author of the digitally encoded material of the generated copy (note column 9, lines 31-39; 57-61 of Matsuyama).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rhodes et al. (U.S. Patent Application Publication 2004/0044629) teach a license file containing processor serial numbers of authorized processors (note paragraph [0052]).

Asano et al. (U.S. Patent Application Publication 2008/0072040) teach a registration list of identification numbers for authorized devices (note paragraph [0040]).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. PEARSON whose telephone number is (571) 272-0711. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm; off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. J. P./
Examiner, Art Unit 2437

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437